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DOCKET NO. SS0166US (NORT10-00208)

PATENT

Customer No. 33000



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re application of: : David Ian Hopper, et al.
Serial No. : 09/222,927
Filed : December 30, 1998
For : PRIVATE BRANCH EXCHANGE BUILT USING AN ATM NETWORK
Group No. : 2665
Examiner : A. Hsu

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement mailed August 12, 2003, Applicant provisionally elects the claims of Group I, claims 1-8 and 13-14, WITH TRAVERSE.

Restriction is only proper where the claims are independent (no relation therebetween) or distinct. MPEP § 806, p. 800-39 (8th ed. rev. 1 February 2003). The restriction requirement concedes that the claims subject to restriction in the present case are not independent, being related as a combination-subcombination (see MPEP § 806.05(a), p. 800-42).

Where claims are related but distinct, restriction may be properly, but only upon a showing of a substantial burden on the Examiner due to: separate classification in the art,

separate status in the art (when classifiable together), or different fields of search. MPEP § 808.02, p. 800-48. The restriction requirement concedes that the claims are subject to the same classification (class 370). The fact that separate subclasses exist within that classification does not establish “separate classification” evidencing recognition in the art as separate subject for invention. Classes are employed in the U.S. patent classification system to define fields recognized in the art as separate subjects for invention, with each class having a scope embracing: the basic subject matter; the basic subject matter combined with a feature for some additional purpose; the basic subject matter combined with a perfecting feature; subcombinations specialized to the basic subject matter; and subcombinations of general utility. See MPEP § 903.02(b), p. 900-33.

Moreover, all claims in the present case have already been examined, and have been the subject of three previous Office Actions dated February 22, 2002, August 14, 2002 and January 27, 2003 (issued by the Examiner currently assigned to the application). No prior art rejection (or rejection under section 112, or any other rejection other than the restriction requirement) is maintained. Accordingly, no showing of the substantial burden on the Examiner in further examination required to support a restriction requirement can be shown at this stage of prosecution. If the search and examination of an entire application can be made without serious burden, the examiner MUST examine the entire application on the merits even if the application contains claims that are independent or distinct. MPEP § 803, p. 800-4.

In addition, to support a restriction requirement on claims related as combination and

subcombination, two-way distinctness must be demonstrated by a showing that (a) the combination does not require the particulars of the subcombination as claimed for patentability (to show novelty and nonobviousness) and (b) the subcombination has utility either by itself or in other and different relations. MPEP § 806.05(c), pp. 800-42-43. The restriction requirement only asserts that “the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination has separate utility such as ATM switch.” The fact that the subcombination has separate utility does NOT establish that the combination does not require the particulars of the subcombination to establish patentability. Moreover, restriction in general and distinctness in particular must be based on comparison of the claimed subject matter. MPEP § 806.01, p. 800-39. In the present case, the elements of independent claims 1 and 9 both recite only the structure and functional configuration of a single controller, thus defining the same essential characteristics of a single disclosed embodiment of the invention, for which restriction is never proper. MPEP § 806.03, p. 800-39.

If any issue arises, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

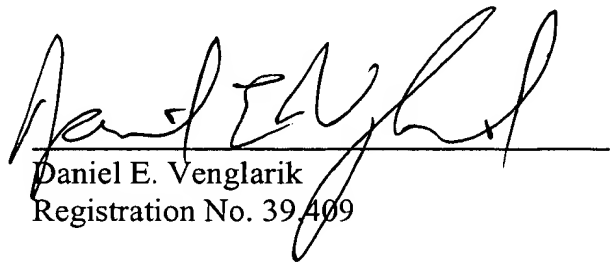
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _____

9-12-03



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